

## REMARKS/ARGUMENTS

Claims 1-9, 12-18, and 20 are pending in the application and have been rejected. Claims 1, 6, 8, 9, 12, 13, 1 and 8 have been amended. Applicant respectfully requests reconsideration of the rejections.

### Rejections under 35 U.S.C. §112.

Claim 9 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicant agrees with the examiner's solution and has amended claims 9 and 12 accordingly. These amendments are not narrowing amendments.

### Rejections under 35 U.S.C. §103

The Office Action rejected claims 1-5 and 13-17 as unpatentable under 35 U.S.C. §103 over US Patent 6,546,405 to Gupta et al (hereafter "Gupta") in view of U. S. Patent 6,366,296 to Boreczky et al (hereafter "Boreczky").

Claim 1 recites a method for applying an annotation file comprising: automatically identifying at least one desired portion of a multimedia presentation by user's equipment; said equipment automatically creating an annotation file for the multimedia presentation, the annotation file containing at least one pointer corresponding to the at least one desired portion of the multimedia presentation and automatically presenting only one or more portions of the multimedia presentation identified as being desired to a user while eliminating any other portions of the multimedia presentation.

The Office Action has not shown that Gupta uses an annotation file having pointers to desired parts of a multimedia presentation. Rather, Gupta relates to a temporal annotation file where a user-authored content is displayed *in addition* to the multimedia presentation. See Gupta, col. 2 lines 7-11 (can *add* annotations); col. 2 line 20 (substantive content *added*); col. 2 lines, 46-47 (user-authored content becomes part of the display). Gupta does not use the annotation to display only the subject matter to

which the claimed pointers point.

The Office Action concedes that Gupta does not disclose the automatic annotation claimed in the instant invention. The Examiner appears to contend that the teaching is not explicit but makes no showing of how Gupta implicitly suggests the claimed invention. Instead, the Office Action contends that Boreczky teaches this annotation element and that it would have been obvious to one skilled in the art to modify Gupta according to Boreczky. The motivation given by the Examiner is that "in Gupta where the goal is to build as comprehensive a set of annotations as is possible, and this would be directly facilitated with the Boreczky teachings of machine-generated metadata." Applicant traverses the conclusion of obviousness.

A piecemeal reconstruction of the prior art patents in light of the applicant's disclosure shall not be the basis for a holding of obviousness. In re Kamm, 172 USPQ 298 (CCPA 1972). Thus, it is impermissible within the framework of section 103 to pick and choose from any one reference only so much as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. Kamm, 172 USPQ at 302. When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)). In this case, the grounds for combining are derived from applicant's own discussion. First, the fact that a combination is possible is not a proper basis for obviousness. The Federal Circuit has rejected such rejections as employing the "obvious to try" standard. In re Geiger, 815 F.2d 868, 2 USPQ2d 1276 (Fed. Cir. 1987). The motivation proposed by the Examiner is also very general. The motivation to combine must be specific, In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998), and supported by actual evidence, In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

Moreover, Boreczky relates to a media browser that based on the information the user can identify and playback the content. One of the problems addressed by Applicant's invention is viewing a multimedia file without having to see certain parts that are automatically determined to be undesirable. In Boreczky the user must see everything to make a selection and the selection is not automatic as claimed. The problem confronted by the inventor must be considered in determining whether it would have been obvious to combine references in order to solve the problem. Northern Telecom, Inc. v. Dataflow, 908 F.2d 931 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675 (Fed. Cir. 1988). It is evident that Boreczky was not concerned with the same problem as Applicant and thus its teachings are irrelevant to obviousness *vel non* of the claimed invention.

Applicant respectfully submits that claims 2-5 would not have been obvious in view of the combination of Gupta and Boreczky at least for the foregoing reasons because these claims are dependent on claim 1.

Claims 3 and 14 additionally distinguish over the combination of Gupta and Boreczky. The part of Gupta cited discusses that the user can select temporal annotations which satisfy various criteria for inclusion in the display of the multimedia document. In other words the user is including **annotation subject matter** in the display of the multimedia content according to criteria. There is no **multimedia content** that is not displayed per the criteria. The claims require that **only** the selected portions of **multimedia** be displayed.

Claim 13 has also been modified to require that the display device displays only the at least one desired portion. The cited part of Gupta discusses displaying one or more portions of the annotation file, not the content file. The claims at issue call for the automatic selection among the parts of the multimedia, not annotation file. Claims 14-17 distinguish patentably over the cited references for at least the same reasons discussed with respect to claim 13 from which they depend.

The Office Action rejected claims 6-9, 12, 18, and 20 under 35 U.S.C. §103 as unpatentable over Gupta in view of U.S. Patent 5,907,322 to Kelly et al (hereafter "Kelly") and Boreczky. Applicant respectfully traverses these rejections.

Claim 6 requires a method for applying an annotation file comprising: broadcasting an event to a first location; simultaneously identifying at least one desired portion of the event at a location remote from said first location; creating an annotation file for the event substantially simultaneously to said broadcasting, the annotation file containing at least one pointer, the at least one pointer corresponding to the at least one desired portion of the event; and transmitting to a viewing system the annotation file as a transmission that is distinct from the broadcast of the event, the annotation file causing the viewing system to automatically display desired portions of the event.

Claim 6 has been amended to require that only desired portions of the event be displayed. Gupta only controls which portions of the temporal annotation file are displayed. Kelly relates to systems for navigating, marking and displaying viewer-selected television broadcast events. See col. 1, lines 4-7. Even if Kelly were combinable (which it is not), the combination of the cited references does not teach or suggest the claimed automatic selection and annotation of a multimedia file such that only selected parts of the multimedia file are shown.

As discussed above the relevance of Kelly is highly diminished by requiring the viewer to make selections. Moreover claim 6 requires that only parts of an event are selected for display, in Kelly the user selects an entire event for viewing. The cited motivation for combining Kelly with the other references is also improper. The motivation is allegedly found in Gupta at col. 3, lines 4-16. That part discusses the storage of user-authored content for display with the multimedia document. Claim 6 requires all require that the annotation file contains pointers. These pointers are obviously not for display. Rather pointers are internal references to content. Gupta's teachings would not have motivated persons skilled in the art to modify Gupta as claimed

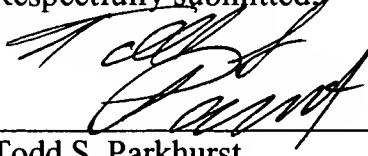
by the Examiner. Claim 7 depends on claim 6 and is not obvious for the same reasons.

Claim 8 applies the annotation file such that only the portions of the multimedia presentation that were identified are displayed. The Office Action cites collection 420 of Gupta which is the annotation file and does not select the multimedia content to be displayed it only selects the time that part of the annotation to be displayed. Claims 9 and 12 depend on claim 8 and are not unpatentable over the cited references for at least the same reasons discussed above.

Claim 18 requires *inter alia* the creation of an annotation file without user prompt or intervention. None of the cited references teaches or suggests this limitation. The Office Action cites the collection 420 as the document being annotated. As noted above, the collection 420 is the annotation file, not the file being annotated. The meaning of annotation file in the claims is different from the temporal annotation of Gupta. The claims specify the annotation files contains pointers to parts of the file being annotated that indicate that those parts are to be displayed. By contrast the temporal annotation contains user-authored content to be displayed. See Gupta, col. 4, lines 52-54. The Examiner's claim construction is not reasonable because it ignores the claim language. The Examiner claims that Gupta, col. 10, line 65-col. 11, lines 35 disclose pointers but no pointers that identify parts of the multimedia file to be displayed are found in that section or anywhere else in Gupta. Claim 20 depends on claim 18 and is patentable for the same reasons.

For the foregoing reasons, Applicant respectfully requests allowance of the pending claims and that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Todd S. Parkhurst', is written over a horizontal line.

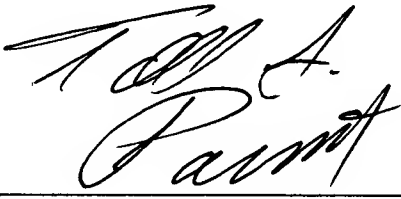
Todd S. Parkhurst  
Reg. No. 26,494

Date: January 11, 2006

HOLLAND & KNIGHT LLP  
Holland & Knight LLP  
131 S. Dearborn, 30<sup>th</sup> Floor  
Chicago, Illinois 60603  
(312) 263-3600  
Attorney for Applicant

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I hereby certify that this Amendment and Response to Office Action, and any documents referred to as attached therein, are being deposited with the United States Postal Office on the date set forth below with sufficient postage as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.



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Date: 11 January 2006

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